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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,088	12/02/2003	Keith Clements	58533.US/1720.0	3423
408	7590	09/27/2004	EXAMINER	
LUEDEKA, NEELY & GRAHAM, P.C. P O BOX 1871 KNOXVILLE, TN 37901			LEWIS, KIM M	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/726,088

Applicant(s)

CLEMENTS ET AL.

Examiner

Kim M. Lewis

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/20/03 and 5/25/0.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statements filed 1/20/03 and 5/25/04 have been received and made of record in the application file wrapper. Note the acknowledged form PTO-1449 enclosed herewith.

### ***Drawings***

2. The drawings are objected to because in Fig. 1, the lead arrow for reference character "22" is missing. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the

Art Unit: 3743

examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,532,921 ("von Torklus et al.").

As regards claim 5, von Torklus et al. disclose a knee joint bandage, which anticipates applicants' claimed invention. More specifically, von Torklus et al. disclose a device for providing support, compression, and warmth to the patellar tendon of a knee. The device comprises an elastic sleeve (1), a compressible tubular member (2) secured along a circumferential length of the sleeve, first and second straps attached on opposite ends of middle portion (a) of supporting strap (3) as shown in Fig. 2 and secured to each other adjacent the exterior of the sleeve and generally diametrically (opposite) across the sleeve from the tubular member, and first and second strap closure members (6, 7) for securing the straps in a tensioned state (abstract and col. 2, lines 25-46).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3743

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,531,921 ("von Torklus et al.").

As regards claims 1 and 3, von Torklus et al. disclose a knee joint bandage, which anticipates applicants' claimed invention. More specifically, von Torklus et al. disclose a device for providing support, compression, and warmth to the patellar tendon of a knee, the device comprising an elastic sleeve (1) having a circumferential length

Art Unit: 3743

and opposite interior and exterior surfaces, a compressible tubular member (2) having first and second opposite end and secured along a circumferential length of the sleeve, first and second straps attached on opposite ends of middle portion (a) of supporting strap (3) as shown in Fig. 2 and secured to each other adjacent the exterior of the sleeve and generally diametrically (opposite) across the sleeve from the tubular member, and first and second strap closure members (6, 7) for securing the straps in a tensioned state (abstract and col. 2, lines 25-46).

Von Torklus et al. fail to disclose the first strap has a hook surface and an adjacent loop surface and being secured adjacent the exterior surface of the sleeve at a first attachment point and the second strap having a hook surface and an adjacent loop surface and being secured adjacent the exterior surface of the sleeve at a second attachment point located generally adjacent to the first attachment point so that the first and second straps may be positioned to extend in generally opposite directions around the exterior circumference of the sleeve, a first strap closure member secured adjacent the exterior surface of the sleeve and positioned between the first attachment point and the first end of the tubular member; and a second strap closure member secured adjacent the exterior surface of the sleeve and positioned between the second attachment point and the second end of the tubular member, wherein the device is positionable on the knee so that the tubular member is generally oriented across a front portion of the knee adjacent the patellar tendon and the device may be tensioned to provide compression and support to the patellar tendon by (1) exerting a first force on the first strap and passing the first strap through the first strap closure member and

Art Unit: 3743

folding the first strap back to secure the hook material and the loop material of the first strap together to maintain application of the first force and (2) exerting a second force on the second strap and passing the second strap through the second strap closure member and folding the second strap back to secure the hook material and the loop material of the second strap together to maintain application of the second force, and wherein the first and second strap closure members each comprise a length of fabric material having the ends thereof attached to sleeve to form a loop and a D-ring encircled by the loop.

While the strap configuration and the manner in which the first and second straps are secured about the sleeve of the present invention are different from those disclosed in von Torklus et al., the equivalent first and second types of forces are still applied to the tubular member, thereby achieving the same result. As such, the examiner contends that the claimed strap configuration is an obvious design choice, which does not patentably distinguish applicant's invention.

Moreover, it would have been obvious to one having ordinary skill in the art to substitute any equivalent strap and fastening configuration for the strap and fastening configuration of von Torklus et al. since the same result is achieved.

As regards claim 2, von Torklus et al. fail to teach a sleeve having a seam. Absent a critical teaching and/or a showing of unexpected results derived from providing a sleeve with a seam, the examiner contend that the seam is an obvious design choice, which does not patentably distinguish applicant's invention.


Art Unit: 3743

As regards claim 4, von Torklus et al. fail to teach the claimed limitation wherein the sleeve has a circumference in an unstretched state of from about 3 to about 4 inches less than the circumference of the knee of the user on which the device is to be positioned. Again, the examiner contends that absent a critical teaching and/or a showing of unexpected results, the claimed limitation is an obvious design choice, which does not patentably distinguish applicant's invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is 703.308.1191. The examiner can normally be reached on Mondays to Thursdays from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 703.308.0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kim M. Lewis  
Primary Examiner  
Art Unit 3743



Application/Control Number: 10/726,088

Page 8

Art Unit: 3743

kml

September 23, 2004